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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Roger Blum

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04/15/2008

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EXAMINER

MELLER, MICHAEL V

ART UNIT

PAPER NUMBER

1655

MAIL DATE

DELIVERY MODE

04/15/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

It is noted that claim 34 should be claim 33 under Rule 1.126. Thus, claim 34 is to be renumbered as claim 33 and referred to in this office action as claim 33.

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

Applicant notes the problem and states that they will take of the oath later.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

Art Unit: 1655

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 13, 26, 27, 28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims do not have written description for any and all food colors. Further they do not have written description for the many different food colors listed in claim 26 either. Finally they do not find written description for the limitations of claims 27 and 28 either.

Applicant has only tested Ponceau 4R, Patent Blue and tartrazine for stability of restriction enzymes. Applicant has not shown that they were in fact in possession of any and all food colors which have the claimed stabilization effect on restriction enzymes. There is no support to show that applicant's had possession of using a food color such as gold, assuming it is even a color. It appears not to make sense on its face that gold could even be a food color. It is a metal and an element but not a food color and certainly one which has not been demonstrated to stabilize a restriction enzyme.

Further, applicant has not shown that they were in possession of the limitations of “up to about 1 week” and for “up to about 6 months”. The only disclosure that applicant has is on page 6 of the specification which only provides support for “after 1 week’s storage at -21°C ” and “after almost a half-year’s storage at -21°C ”, but not what they have claimed.

The amendments to claims 27 and 28 raise new matter issues since they do not find support from the original disclosure. The amendments, “period of more than 1 week” and “period of up to 6 months” do not find support from the original disclosure.

Applicant argues that the preliminary amendment filed 9/17/2001 supplies the needed disclosure to support the extraordinary vast possibilities of food colors that are encompassed by claim 13. This is not agreed with simply because there is no way that the preliminary amendment could possibility show that each and every food color known to man could perform the claimed method of storing a restriction enzyme by using any food color. Applicant’s themselves have argued that the unique combination of their ponceau 4R, patent blue and tartazine have all yielded unexpected results, which does not clearly read on any and all food colors. Any and all food colors cannot possibility provide such unexpected results, otherwise, applicant’s combination would not be unexpected, thus patentable.

Claim Rejections - 35 USC § 112

1.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 3.

4. Claim 33 (labeled as claim number 34 in applicant's amendment which should be claim 33) is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 34 (claim 33) is a substantial duplicate of claim 31.

Claims 29-32 are allowable if written in independent form.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael V. Meller whose telephone number is 571-272-0967. The examiner can normally be reached on Monday thru Thursday: 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael V. Meller/
Primary Examiner, Art Unit 1655

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